IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

    Carl J. EVANS et al.

Application No.: 09/304,787	Group Art Unit: 2684
Filed: May 4, 1999	Examiner: Sobutka, P.
Attorney Docket: 09710-1113	
Client Docket: COS-98-009	

For: ADVERTISEMENT BROADCASTING FOR PAGING

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APPEAL BRIEF

Honorable Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This Appeal Brief is submitted, in triplicate, in support of the Notice of Appeal filed July 31, 2003.

I.   REAL PARTY IN INTEREST

WorldCom, Inc. is the real party in interest.

II.   RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III.   STATUS OF THE CLAIMS

Claims 1-7, 13-28 are pending in this appeal. No claim is allowed. This appeal is therefore taken from the final rejection of all claims on April 10, 2003.

IV.   STATUS OF AMENDMENTS

The amendment filed June 10, 2003 was not entered and is not relied upon in this appeal.

V.   SUMMARY OF THE INVENTION

An example of the present invention will be summarized by reference to the disclosed embodiment (the citations are to the specification unless otherwise noted).

The largest single customer complaint with paging service today is the cost. Accordingly, there is a need to reduce the cost of paging services. (Specification, page 2)

In the present invention on appeal, new information associated with an advertisement script is added in generating an otherwise standard pager identification capcode, and the new information is used in attaching the associated advertisement script so identified to a message.

Each advertiser would pay the paging service provider, and the resulting savings are passed along to the customers. Thus, there is a dual benefit to reduce the cost of paging services, while allowing companies to easily get their advertisements directly to a specific market. (Specification, page 3)

The system 100 of Figure 1 has a broadcast operator 110, who receives an advertisement script for each advertisement to be broadcast. Different ads can target different groups through the use of the associated capcodes. The capcode is an identification number programmed into the paging unit. The number of advertisements that the paging service customer desires to receive and/or the number of times a day the customer wants to receive advertisements determines which capcode(s) are programmed into an individual's pager. For example, different capcodes are generated depending on the number of advertisements and the frequency of transmission, and upon subscriber types, for example residential and business types. (Specification, pages 7 - 9)

If a pager's capcode has been programmed to receive an advertisement (providing an association between the advertisement and the capcode) the central computer 120 uplinks associated advertisements along with a message intended for that pager. The satellite 140 then relays to a downlink station 150, which in turn relays to a transmitting station 160 for broadcast of the message and advertisement to the pager 170. When the individual reviews the message, he or she will also see or hear the advertisement. (Specification, pages 8 and 9) The capcode indicates to the paging service provider that associated advertisements are acceptable. (Specification, Abstract)

VI. ISSUE

Whether claims 1-7, 13-28 are obvious under 35 U.S.C. § 103(a) based on *Taubenheim et al.* (US 6,060,997) in view of *Fascenda et al.* (US 5,241,305), *Lewis et al.* (US 5,594,945), *DeLuca et al.* (US 5,870,030), *Yeh et al.* (US 6,208,717) and *Dimitriades et al.* (US 5,664,948)?

VII. GROUPING OF CLAIMS

The claims should not be regarded as all standing together since the claims recite respective limitations that render each of the claims separately patentable. For the purposes of this appeal, the following group is recognized:

Claims 1-7, 13-28: Claim 1 is representative.

VIII. <u>ARGUMENT</u>

A. <u>THE EXAMINER'S BURDEN</u>

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne*, 41 USPQ2d 1451 (Fed .Cir. 1997); *In re Deuel*, 34 USPQ2d 1210 (Fed. Cir. 1995). The Examiner is required to show that all the claim limitations are taught or suggested by the references. *In re Royka*, 180 USPQ 580 (CCPA 1974); *In re Wilson*, 165 USPQ 494 (CCPA 1970). Obviousness rejections require some evidence in the prior art of a teaching, motivation, or suggestion to modify the prior art references. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). The Administrative Procedures Act (APA) mandates the Patent Office to make the necessary findings and provide an administrative record showing the evidence on which the findings are based, accompanied by the reasoning in reaching its conclusions. See *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

B. CLAIMS 1-7, 13 -28 ARE NOT OBVIOUS OVER *TAUBENHEIM ET AL.* IN VIEW OF *FASCENDA ET AL., LEWIS ET AL., DELUCA ET AL., YEH ET AL.* AND <u>*DIMITRIADES ET AL.*</u>

Claim 1 recites:

> "... capcode ...; and
> attaching ... advertisement script to a message for a paging service
> subscriber associated with the capcode."

The above claim features are in the prior art. The Examiner applied *Fascenda et al.* for a teaching to provide each *Taubenheim et al.* pager with a capcode; however, this is unnecessary,

because, according to Newton's Telecom Dictionary, 17th Edition, each *Taubenheim et al.* pager

already has a capcode:

> "A capcode is a four or seven digit number on either side or near the casing of a pager; the type you wear on your belt. This number is a paging system necessity to know how to generate the right sequence of tones to alert the pager. Also spelled cap code."
> (Newton, page 123).

Fascenda et al. explains how such a standard capcode is used, which could apply to one

of the uses of the capcode of the Appellant's embodiment:

> "Each pager has an individual ID, called the capcode, stored in the pager. All the pagers in an area monitor broadcast messages from a central transmitter. Each message is intended for a particular pager and has that pager's capcode associated with the message. Thus, pagers in an area all monitor a certain frequency for broadcasts from the pager system transmitter looking for its capcode." (col. 1: 15-25).

However, claim 1 recites more than the standard capcode and method of its use:

> "**generating a capcode associated with an advertisement script**; and
> attaching the advertisement script to a message for a paging service subscriber associated with the capcode." (*emphasis added*)

In *AT&T Corp. v. Excel Communications, Inc*, the limitations found to be patentable

subject matter under 35 U.S.C. §101 similarly involved adding new information to a standard

identification code and using the new information advantageously.

> "The invention of the '184 patent calls for the addition of a data field into a standard message record to indicate whether a call involves a particular PIC (the "PIC indicator"). This PIC indicator can exist in several forms, such as a code. . . . The PIC indicator therefore enables IXCs to provide differential billing for calls on the basis of the identified PIC. . . . The independent claims at issue . . . include the step of 'generating a message record for an interexchange call between an originating subscriber and a terminating subscriber,' and the step of adding a PIC indicator to

the message record." (*AT&T Corp. v. Excel Communications, Inc.*
172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999))

In view of *AT&T Corp. v. Excel Communications, Inc,* the emphasized limitations quoted

from claim 1 and the advantages thereof not found in the standard capcode or its standard use are

patentable subject matter and cannot be ignored.

Taubenheim et al. has no teaching or suggestion for generating an association between an

advertisement script and a capcode, and attaching the advertisement script according to the

capcode. Appellant's embodiment uses the capcode, not only for association with a specific pager

(such functionality being inherent in the definition of capcode), but also for association with an

advertisement script (e.g., via programming of certain capcode bits during the recited step of

generating the capcode).

In fact, *Fascenda et al.* teaches away from the claimed invention, by stating that one

drawback of pager systems is that they are not flexible, because the capcodes are set by the

manufacturer or local paging company, they are not easily changed. (col. 2:38-44)

Lewis et al., DeLuca et al., Yeh et al., and *Dimitriades et al.* do not cure the noted

deficiencies of *Taubenheim et al.* and *Fascenda et al.*

Although the Examiner does not address the emphasized limitations of claim 1, a

modification of the prior art to meet the emphasized limitations of claim 1 would be based on

impermissible hindsight. *In re Gorman,* 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991)

Therefore, the Examiner has failed to show any more of the invention than Newton's

Telecom Dictionary definition of a capcode. The references do not <u>associate a capcode with an</u>

<u>advertisement attached to a message for a pager associated with that capcode.</u> There is no

teaching beyond Appellant's disclosure for the combination of the references, which in fact teach away.
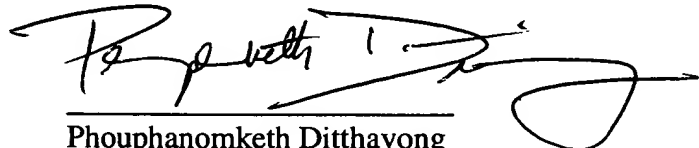
IX. CONCLUSION AND PRAYER FOR RELIEF

The claims require generating an association between an advertising script and a capcode, and attaching the advertising script according to the capcode. No combination of the references provides or suggests this limitation. Appellants, therefore, request the Honorable Board to reverse each of the Examiner's rejections.

Respectfully Submitted,

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_10/1/03_
Date

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APPENDIX

1. A method of messaging, comprising:

generating a capcode associated with an advertisement script; and

attaching the advertisement script to a message for a paging service subscriber associated

with the capcode.

2. The method of Claim 1, further comprising:

storing the generated identification number in a central database;

programming a paging unit of the paging service subscriber with the identification

number;

correlating the identification number stored in the central database with the identification

number programmed into the paging unit; and

transmitting the advertisement script and the message to the paging unit programmed with

the identification number based upon the correlation.

3. The method of Claim 2, wherein the step of attaching the advertisement script to the page

message comprises transmitting the advertisement script prior to transmitting the message.

4. The method of Claim 2, wherein the step of attaching the advertisement script to the page

message comprises transmitting the advertisement script after transmitting the message.

5. A method of providing messaging services to paging units, comprising:

generating a capcode associated with an advertisement script, wherein the generated

capcode is stored in a central database;

programming a paging unit of a paging service subscriber with the capcode;

attaching the advertisement script to a message for the paging service subscriber

associated with the programmed capcode; and

transmitting the advertisement script and the message to the paging unit.

6. The method of Claim 5, wherein the step of attaching the advertisement script to the page

message comprises transmitting the advertisement script prior to transmitting the message.

7. The method of Claim 5, wherein the step of attaching the advertisement script to the page

message comprises transmitting the advertisement script after transmitting the message.

14. A method of messaging, comprising:

generating a capcode associated with an advertisement script, wherein the capcode is

among a plurality of capcodes corresponding to a plurality of paging service subscriber types;

and

attaching the advertisement script to a message for a paging service subscriber associated

with the capcode.

15. The method of Claim 14, wherein the plurality of paging service subscriber types includes at

least one of residential paging service subscribers, business paging service paging subscribers,

small business paging service subscribers, and large business paging service subscribers.

16. A method of messaging, comprising:

generating a capcode among a plurality of capcodes associated with an advertisement

script; and

attaching the advertisement script to a page message for a paging service subscriber

having the capcode.

17. The method of Claim 16, wherein the plurality of capcodes corresponds to at least one of a

number of advertisement scripts to be attached and a number of times a day the paging service

subscriber receives an advertisement script.

19. A method for supporting messaging to paging units, comprising:

generating a capcode associated with an advertisement script, wherein the generated

capcode is stored in a central database, the capcode corresponding to a paging service

subscriber type; and

programming a paging unit of a paging service subscriber with the capcode, wherein the

advertisement script is transmitted with a message for the paging service subscriber having

the programmed capcode.

20. The method of Claim 19, wherein the plurality of paging service subscriber types includes at

least one of residential paging service subscribers, business paging service paging subscribers,

small business paging service subscribers, and large business paging service subscribers.

21. A method for supporting messaging to paging units, comprising:

generating a capcode among a plurality of capcodes associated with an advertisement script, wherein the generated capcode is stored in a central database;

programming a paging unit of a paging service subscriber with the capcode, wherein the advertisement script is transmitted with a message for the paging service subscriber having the programmed capcode.

22. The method of Claim 21, wherein the plurality of capcodes corresponds to at least one of a number of advertisement scripts to be attached and a number of times a day the subscriber receives an advertisement script.

23. A method of messaging, comprising:

generating a capcode associated with at least one paging service subscriber;

attaching an advertisement script to a message for the paging service subscriber associated with the capcode; and

replaying said advertisement script as a voice signal.

24. The method of Claim 1, further comprising replaying said advertisement script as a voice signal.

25. The method of Claim 5, further comprising replaying said advertisement script as a voice signal.

26. The method of Claim 14, further comprising replaying said advertisement script as a voice signal.

27. The method of Claim 16, further comprising replaying said advertisement script as a voice signal.

28. The method of Claim 1, wherein the advertisement script includes wording of an advertisement and a date and time of when to broadcast the advertisement.